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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Robert Greiner

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EXAMINER

KHATRI, PRASHANT J

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

03/13/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Attachment to Advisory Action**

In response to After-Final Arguments/Amendments filed 3/2/2009. Claims 9-18 are pending.

The amendment has been entered.

Regarding the written description rejection, Applicant asserts that the phrase “a conductive fiber and/or particle in a proportion of at least 30% by weight” is supported by the specification. It appears that Applicant is presently claiming the range as being from 30% to 100% by weight, however, support is not found for any value greater than 70%. Furthermore, Applicant points to the bottom of page 4 and second paragraph on page 5 as support for the present limitation. However, it appears that the present claims recite the limitation as for only the conductive fiber and/or particle and the portions of the specification disclosed as support are drawn to the sum of the low melting point alloy and conductive fiber and/or particle. Given that the present claims do not have support for limits up to 100%, the written description rejection is maintained. *In re Lukach*, 442 F.2d 967, 169 USPQ 795 (CCPA 1971). It has been held that when an explicit limitation in a claim “is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description **requires** that limitation” (emphasis added). *Hyatt v. Boone*, 146 F.3d 1348, 1353, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998). Applicants state that the test for sufficiency of written description is whether

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the disclosure reasonably conveys to the artisan that the inventor had possession at the time of filing of the subject matter which is claimed and then sets forth criteria that would meet this test. However, it is the Examiner's position that none of the cited six criteria for the test are met by the present application and further that there is no disclosure or suggestion in the specification as originally filed to use amounts of conductive fiber or filler in all amounts greater than 30% including 75%, 80%, etc. and nothing to suggest that one of ordinary skill in the art would have understood that the description requires that limitation.

Concerning the lwase rejection, Applicant asserts that lwase cannot form a fiber network and that the fibers are straight. However, as shown in Figure 4, it appears that the fibers are not straight. Further, it is noted that "the arguments of counsel cannot take the place of evidence in the record", *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). It is the examiner's position that the arguments provided by the Applicant regarding the process of lwase not forming a fiber network and that the fibers disclosed by lwase a straight must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), "the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001". Applicant further asserts that the low-melting metal is free of lead. However, it is noted that the present claims recite the phrase "includes proportions of bismuth, zinc, and/or tin". Given that the transitional phrase is "includes" is inclusive or open-ended and does not exclude

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additional, unrecited elements, the rejection is maintained. *See MPEP 2111.03 [R-3]*.

Applicant also asserts that amount of conductive filler is at most 30% by weight. While it is acknowledged that the prior art recites that limitation, it is noted that at 30% by weight, the prior art would still meet the present limitation reciting "at least 30% by weight" given that the amount is 30 wt% and up. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. free of lead) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *See In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding the Ito rejection, Applicant asserts that the dibutyltin maleate is not the presently claimed metal compound. However, that the metal compound is defined as a "metallic compound whose melting point or melting range lies between 100C and 400C..." Therefore, the present disclosure of Ito would meet the present limitations. Applicant further asserts that the metal compound does not include an organic compound. However, it is noted that the present claims recite the phrase "includes proportions of bismuth, zinc, and/or tin". Given that the transitional phrase is "includes" is inclusive or open-ended and does not exclude additional, unrecited elements, the rejection is maintained. *See MPEP 2111.03 [R-3]*. The rejection is therefore, maintained.

Concerning the Katsumata rejection, Applicant asserts that carbonaceous material would “inherently avoid the build-up of a network”. However, it is noted that “the arguments of counsel cannot take the place of evidence in the record”, *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). It is the examiner's position that the arguments provided by the applicant regarding that Katsumata does not contain a network buildup must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), “the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001”. Applicant also asserts that metal conductive fiber is from 0.5 to 30 wt%. While this limitation is acknowledged, it is noted that at 30% by weight, the prior art would still meet the present limitation reciting "at least 30% by weight" given that the amount is 30 wt% and up. The rejection is therefore, maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRASHANT J. KHATRI whose telephone number is (571)270-3470. The examiner can normally be reached on M-F 8:00 A.M.-5:00 P.M. (First Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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PRASHANT J KHATRI  
Examiner  
Art Unit 1794

/Callie E. Shosho/  
Supervisory Patent Examiner, Art Unit 1794